



Paper No. 8

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Technology Center 2100

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| In re Application of: Shigeki Ohbayashi |) | |
| Application No. 09/196,136 |) | |
| Filed: November 20, 1998 |) | DECISION ON PETITION UNDER 37 |
| For: SEMICONDUCTOR INTEGRATED |) | C.F.R. § 1.181 TO WITHDRAW |
| CIRCUIT HAVING BONDING |) | HOLDING OF ABANDONMENT |
| OPTIONAL FUNCTION |) | |

This decision is in response to the communication filed May 6, 2002 which is being treated as a petition under 37 C.F.R. § 1.181 requesting the Withdrawal of the Holding of Abandonment of the above-identified application. (See MPEP § 711.03(c)).

The petition is **DISMISSED**.

This application was held abandoned for failure to timely file a proper reply to the Office Action of mail date August 16, 2001. A Notice of Abandonment was mailed on April 18, 2002.

In the absence of any apparent irregularity associated with the mailing of an Office communication, the Office may presume that the communication was properly mailed to the address of record. This presumption may be overcome by showing that the Office communication was not received.

RECENT CASE HISTORY

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|------------------|---|---|
| January 19, 2001 | - | Office Action (Paper No. 2) mailed setting a shortened statutory period of response to expire three months from the mailing date of the action. |
| July 25, 2001 | - | Applicant filed a Correspondence Address Change (Paper No. 3) |
| August 16, 2001 | - | Office Action of January 19, 2001 remailed (Paper No. 4) resetting the period of reply to expire three months from the mailing date of the remailed action. |
| April 18, 2002 | - | Notice of Abandonment (Paper No. 6) was mailed. |
| May 6, 2002 | - | Applicant filed Petition to Withdraw the Holding of Abandonment. |

BASIS OF OPINION

The relevant portions of the Statutes and Rules are reproduced below. Emphasis is added to draw attention to the critical phrases.

35 U.S.C. 133 Time for prosecuting application

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

37 CFR § 1.135 Abandonment for failure to reply within time period

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

M.P.E.P. § 711.03(c), section II states:

The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

OPINION

Based on *35 U.S.C. 133*, Applicant is given six months, or within such shorter time, as indicated in an Office communication, to prosecute the application after any action therein. If Applicant fails to do so, the application is regarded as abandoned.

Examiner issued an Office Action on January 19, 2001, setting a shortened statutory period of response to expire 3 months from the mailing date of the action. Because Applicant failed to provide a timely reply to the Office Action within the 3 month shortened statutory period or the maximum 6 month statutory period (which expired July 19, 2001), the application was abandoned.

Applicant provided a new correspondence address on July 25, 2001. Examiner then remailed the Office

Action on August 16, 2001. The record shows that this mailing was sent to the old address. However, this is irrelevant as the entire mailing was ineffective. Because no response was received within the 6 month statutory period the application was already in abandoned status at the time of the remailing. The Examiner was without authority to issue an action outside the 6 month statutory period.

In support of the petition, the Petitioner, Stephen A. Becker, provides a "copy of the automated docket of our Docketing Department for the above application, and also copies of the pages from the Docket Book of the undersigned's secretary for the due date of November 16, 2001" and points out that the "official action due date does not appear on either docket record listing". Note that there is no explanation of the electronic record keeping system and the record provided and therefore it is not clear what information this evidence is meant to convey.

Applicant's submission provides evidence that the Office Action was not received at the firm's Washington DC address. To overcome the presumption of proper mailing, a showing must be made with respect to the address of record. The address of record at the time the January 19th Office Action was mailed was Applicant's address at Canal Center Plaza, in Alexandria, VA. Since the showing was made with respect to the Washington DC address and not Applicant's address in Alexandria, VA, the showing is insufficient. *Furthermore, the showing of nonreceipt must be made for the January 19th Office Action, not the August 16th remailing.*

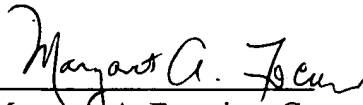
CONCLUSION

Because Applicant failed to provide a timely reply to the Office Action of mail date January 19, 2001, within the 3 month shortened statutory period or the maximum 6 month statutory period, the application was correctly abandoned.

The showing of nonreceipt is insufficient because it was made for the August 16th action, rather than the January 19th action.

Accordingly, the petition for Withdrawal of Holding of Abandonment is **DISMISSED**.

If the petitioner desires further review of this Decision, applicant should consider filing a Request for Reconsideration within 2 months of the mailing date of this Decision.


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